



DOCKET NO.: 192400US55X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

David SUDA, et al. : EXAMINER: RHEE, J.

SERIAL NO: 09/675,180 :

FILED: September 29, 2000 : GROUP ART UNIT: 1745

FOR: BACKING SHEET, AND :  
SYSTEM AND METHOD  
OF FABRICATION THEREOF

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The Appellants hereby submit an appeal brief in compliance with 37 CFR 41.37 to appeal the final rejection of Claims 19, 20, 32, and 33, as set forth in the final Office Action dated April 20, 2005. The fee set forth in 37 CFR 41.20(b)(2) is submitted herewith.

I. REAL PARTY IN INTEREST

The real party in interest is Certainteed Corporation of Valley Forge, Pennsylvania.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

Application Serial No.: 09/675,180  
David SUDA, et al.

### III. STATUS OF CLAIMS

Claims 1-18 and 21-31 have been canceled. Claims 19, 20, 32, and 33 are active, finally rejected, and appealed.

### IV. STATUS OF AMENDMENTS

All amendments have been entered. No amendments after final were submitted.

### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to a backing sheet for insulation and, more specifically, to a backing sheet having stapling tabs. (Page 1, lines 7-9, of the application.)

The claimed invention includes a backing sheet for insulation, where the backing sheet comprises a front side having an adherent material thereon, a back side, a stapling tab extending along an edge of the backing sheet, the stapling tab having a first portion of the back side positioned against a second portion of the back side, and at least one hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts the back side. (See, e.g., original Claim 19, Figures 4A-4C and 5, and the discussion on pages 12-14 of the third embodiment for support.)

For example, in the non-limiting embodiment of Figures 4A-4C and 5, a backing sheet (100) for insulation is depicted. The backing sheet (100) of this embodiment includes a front side (102) having an adherent material (108) thereon, a back side (104), and a stapling tab (105) extending along an edge of the backing sheet (100). (Page 12, lines 20-31, and see page 7, lines 1-4 and 9-10.) The stapling tab (105) has a first portion (122) of the back side (104) positioned

against a second portion (124) of the back side (104). (Page 13, lines 2-4, and see page 7, lines 19-21.) At least one hole (140) extends through the backing sheet (100) such that a portion (150) of the adherent material extends through the hole (140) and contacts the back side (104). (Page 12, line 29, and page 13, line 13.)

#### VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 19, 20, 32, and 33 are not patentable as obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 5,591,521 (Arakawa et al.).

#### VII. ARGUMENT

Regarding the issue on appeal, the final Official Action uses the teachings of Arakawa et al. in order to arrive at the invention recited in independent Claim 19. However, the Examiner has committed reversible error in concluding the claimed invention to be obvious over the cited art.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See M.P.E.P. §2143.) The Appellants submit that that a *prima facie* case of obviousness has not been established in the present case because Arakawa et al. does not

teach or suggest all of the limitations recited in independent Claim 19 of the present application, and (2) there was no motivation to modify Arakawa et al. to arrive at the claimed invention.

1. Arakawa et al. does not teach or suggest all of the limitations recited in independent Claim 19.

Claim 19 of the present application recites a backing sheet for insulation comprising, among other features, a front side having an adherent material thereon, and at least one hole extending through the backing sheet such that a portion of the adherent material extends through the at least one hole and contacts a back side.

The Official Action dated April 20, 2005, incorporates by reference at the top of page 2 thereof the arguments set forth in September 3, 2004. In item number 5 on pages 4-5 of the Official Action dated September 3, 2004, the Examiner indicates that Arakawa et al. teaches a backing sheet as depicted in Figure 1 that has a front side with adhesive layers (3 and 4) thereon, and a back side with a releasing treatment layer (2) thereon.

However, the Examiner expressly admits on page 5 of the Official Action dated September 3, 2004, that “Arakawa et al. fails to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side.” The Appellants agree with this conclusion. None of the embodiments of the invention described or depicted in Arakawa et al. include a hole as recited in Claim 19 of the present application. Furthermore, Arakawa et al. does not suggest the use of such a hole in the invention described therein. Thus, the Appellants submit that a *prima*

*facie* case of obviousness has not been established in the present case because Arakawa et al. does not teach or suggest all of the limitations recited in independent Claim 19 of the present application, which is an express requirement under M.P.E.P. §2143.

Accordingly, for at least this reason, the Appellants request that the obviousness rejection of Claim 19 based on Arakawa et al. be reversed.

2. There was no motivation to modify Arakawa et al. to arrive at the invention recited in independent Claim 19.

In the Official Action dated April 20, 2005, and the Official Action dated September 3, 2004, the Examiner suggests that the hole recited in Claim 19 of the present application, though not taught or suggested in the teachings of the invention of Arakawa et al., would have been obvious to one of ordinary skill in the art to include in the invention of Arakawa et al. based upon a statement made in the Background of the Invention section in column 1, lines 37-39, of Arakawa et al. The Appellants respectfully disagree with this conclusion, and submit that the statement being relied upon actually teaches away from the modification of the invention described in Arakawa et al. to include such a hole.

In column 1, lines 37-39, of Arakawa et al., it is stated that “in the foregoing pressure-sensitive adhesive tape, the 1<sup>st</sup> leg (c) is stuck to the 3<sup>rd</sup> leg (a) with an adhesive by forming a penetrated hole at the central portion of the 2<sup>nd</sup> leg (b) portion....” The Examiner uses this somewhat cryptic description to conclude that “it is notoriously well-known in the art at the time applicant’s invention was made to provide a first leg of adhesive by forming a penetrated hole in the central portion of the second leg portion,” and “[t]herefore, the second

leg would have a hole that extends through the second leg such that a portion of the adherent material extends through the hole and contacts the third leg.” However, the Appellants submit that, in the same sentence referred to by the Examiner, Arakawa et al. clearly and expressly teaches away from the use of such a hole.

Arakawa et al. reference states, in total, that “*since* in the foregoing pressure-sensitive adhesive tape, the 1<sup>st</sup> leg (c) is stuck to the 3<sup>rd</sup> leg (a) with an adhesive by forming a penetrated hole at the central portion of the 2<sup>nd</sup> leg (b) portion, *there are problems that the adhesive is exuded through such a penetrated hole to make rewinding impossible and the tape becomes sticky to use to give an unpleasant feeling to the customer.*” (Column, 1, lines 36-42, emphasis added.) Thus, Arakawa et al. teaches away from the use of such a hole, due to the problems annunciated in the quotation above. Accordingly, Arakawa et al. teaches a configuration for an adhesive tape that does not include such a hole and therefore does not have the annunciated problems specific to absorptive articles that are worn by people, which are the concern of Arakawa et al.

As noted in MPEP 2141.02, the references must be considered in their entirety, *including the disclosures that teach away from the claims.* Thus, the portion of Arakawa et al. that teaches away from the inclusion of such a hole cannot be overlooked.

Furthermore, the Appellants submit that modifying the invention taught in Arakawa et al. to include a hole would render the invention unsatisfactory for its intended purpose, based upon the teaching in the background of the invention section of Arakawa et al. by making rewinding impossible and by making the tape sticky to use and giving an unpleasant feeling to the customer. As noted in MPEP 2143.01, if the proposed modification would render the prior

art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Thus, for the above reasons, no motivation existed to modify the invention described in Arakawa et al. to arrive at the present invention recited in Claim 19.

The Appellants respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Appellants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Thus, the Appellants submit that a *prima facie* case of obviousness has not been established in the present case because there was no motivation to modify the invention of Arakawa et al. to arrive at the invention recited in independent Claim 19 of the present application, which is an express requirement under M.P.E.P. §2143.

Accordingly, for at least this reason, the Appellants request that the obviousness rejection of Claim 19 based on Arakawa et al. be reversed.

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3. Conclusions.

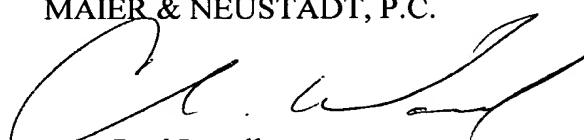
For the reasons set forth in detail above, the Appellants submit that a *prima facie* case of obviousness has not been established in the present case, and therefore request that the obviousness rejection of Claim 19 based on Arakawa et al. be reversed.

Claims 20, 32, and 33 are considered allowable for at least the reasons advanced for Claim 19 from which they depend. Therefore, the Appellants request that the obviousness rejections of Claims 20, 32, and 33 based on Arakawa et al. be reversed.

The Appellants therefore respectfully submit that all of the pending claims are patentable, and so requests that the final rejection be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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CLAIMS APPENDIX

1-18. (Canceled)

19. (Previously Presented) A backing sheet for insulation, said backing sheet comprising:

a front side having an adherent material thereon;

a back side;

a stapling tab extending along an edge of said backing sheet, said stapling tab having a first portion of said back side positioned against a second portion of said back side; and at least one hole extending through said backing sheet such that a portion of said adherent material extends through said at least one hole and contacts said back side.

20. (Previously Presented) The backing sheet according to Claim 19, wherein said stapling tab comprises:

a first fold extending along an edge of said backing sheet, said first fold having a first portion of said front side positioned against a second portion of said front side; and

a second fold extending along the edge of said backing sheet contiguous with said first fold, said second fold having said first portion of said back side positioned against said second portion of said back side.

21-31. (Canceled)

32. (Previously Presented) The backing sheet according to Claim 19, wherein said stapling tab comprises:

a first fold extending along an edge of said backing sheet, said first fold having a first portion of said front side bonded to a second portion of said front side by said adherent

material.

33. (Previously Presented) The backing sheet according to Claim 19, wherein said portion of said adherent material extending through said at least one hole bonds said first portion of said back side to said second portion of said back side.

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EVIDENCE APPENDIX

The following documents are attached hereto:

- (1) Arakawa et al. reference (U.S. Patent No. 5,591,521), which was listed in a Form PTO-892 attached to the Official Action dated September 3, 2004;
- (2) Official Action dated September 3, 2004; and
- (3) Official Action dated April 20, 2005.

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RELATED PROCEEDINGS APPENDIX

There are no related appeals or interferences.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,180	09/29/2000	David Suda	192400US55X	2909
22850	7590	09/03/2004		EXAMINER
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				RHEE, JANE J
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Linked to OPTMS

9-8-04	192400US55X
DATE	CASE ID

Zmw

RECEIVED: 9/7/04  
OBLON, SPIVAK, McCLELLAND  
MAIER & NEUSTADT, P.C.  
DOCKETING DEPT.  
Initials/Date Docketed: WJP 9/7/04  
Type of Resp(s): RD  
Due Date(s): 12/3/04

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/675,180	SUDA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jane Rhee	1772

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 February 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11,13,14,19,20,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11,13,14,19,20,32 and 33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_



## **DETAILED ACTION**

### ***Rejection Withdrawn***

The 35 U.S.C. 103 rejection of claim 14 over Bose et al. in view of Bloch et al. has been withdrawn due to applicant's amendment in response 2/5/2004.

### ***Allowance Withdrawn***

2. The indicated allowability of claims 11,13,19-20,32-33 is withdrawn in view of the newly discovered reference(s) to US 5591521, Arakawa et al. Rejections based on the newly cited reference(s) follow.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 11,13-14,19-20,32-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

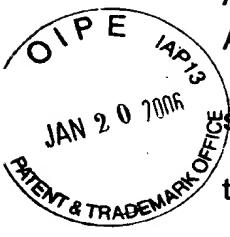
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11,13 are rejected under 35 U.S.C. 102(b) as being anticipated by Arakawa et al. (5591521)

Arakawa et al. discloses a backing sheet comprising a front side having adherent material thereon (figure 1 number 4), a back side (figure 1 number 2), a

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stapling tab extending along the edge of the backing sheet (figure 1 number 1), the stapling tab having a first portion of the back side positioned against a second portion of the back side, and a tacky substance bonding the first portion of the back side to the second portion of the back side (figure 1 number 7), wherein the stapling tab comprises (figure 1 number 1) first fold extending along an edge of the backing sheet, the first fold having a first portion of the front side bonded to a second portion of the front side by adherent material (figure 1 number 3 where a and b connect), and a second fold extending along the edge of the backing sheet contiguous with the first fold, the second fold having the first portion of the backside positioned against the second portion of the back side (figure 1 number 7 where b and c connect). Arakawa et al. discloses that the tacky substance is located on the backing sheet in an area extending inward from an edge of the first fold by predetermined width (figure 1 number 3).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. in view of Bloch et al. (5780150).

Arakawa et al. teaches the backing sheet described above. Arakawa et al. fail to disclose that the tacky substance is starch solution. Bloch teaches a

starch adhesive placed between a paper film and a plastic film for the purpose of providing a strong bond between the paper and plastic ply, which resists delamination (col. 3 line 20-23). Thus, one of ordinary skill in the art would have recognized that the starch solution provide a strong bond between two substances as taught by Bloch.

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Arakawa et al. with a starch adhesive in order to provide a strong bond, which resists delamination (col. 3 line 20-23) as taught by Bloch et al.

5. Claims 19-20,32-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. (5591521).

Arakawa et al. discloses a backing sheet comprising a front side having adherent material thereon (figure 1 number 4), a back side (figure 1 number 2), a stapling tab extending along the edge of the backing sheet (figure 1 number 1), the stapling tab having a first portion of the back side positioned against a second portion of the back side, and a tacky substance bonding the first portion of the back side to the second portion of the back side (figure 1 number 7), wherein the stapling tab comprises (figure 1 number 1) first fold extending along an edge of the backing sheet, the first fold having a first portion of the front side bonded to a second portion of the front side by adherent material (figure 1 number 3 where a and b connect), and a second fold extending along the edge of the backing sheet contiguous with the first fold, the second fold having the first

portion of the backside positioned against the second portion of the back side (figure 1 number 7 where b and c connect).

Arakawa et al. fail to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side. However, Arakawa et al. teaches that it is notoriously well known in the art at the time applicant's invention was made to provide a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the second leg portion (col. 1 lines 37-39). Therefore, the second leg would have a hole that extends through the second leg such that a portion of the adherent material extends through the hole and contacts the third leg.

Thus, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Arakawa et al. with at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side in order to adhere the first leg (portion) to a third leg (portion) together as taught by Arakawa et al.'s background disclosure (col. 1 lines 37-39).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee  
August 24, 2004

*Nasser Ahmad*  
NASSER AHMAD  
PRIMARY EXAMINER 8/30/04

<b>Notice of References Cited</b>		Application/Control No.	Applicant(s)/Patent Under Reexamination	
		09/675,180	SUDA ET AL.	
Examiner		Art Unit		Page 1 of 1
Jane Rhee		1772		

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-5,591,521	01-1997	Arakawa et al.	428/352
B	US-			
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,180	09/29/2000	David Suda	192400US55X	2909

22850 7590 04/20/2005  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

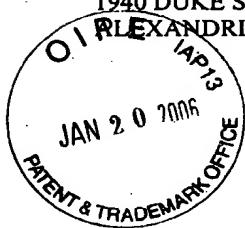
RHEE, JANE J

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1745

DATE MAILED: 04/20/2005



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MAIER & NEUSTADT, P.C.

DOCKETING DEPT

Initials/Date Docketed: 4/21/05  
Type of Resp(s): P.D / N.P (1st)  
Due Date(s): 7/20/05 / 8/20/05

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/675,180	SUDA ET AL
	Examiner	Art Unit
	Jane Rhee	1745

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- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12/3/2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19,20,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19,20,32 and 33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

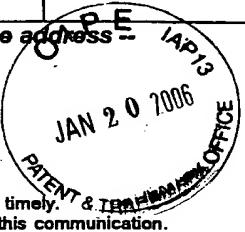
#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/10/2003.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_





## **DETAILED ACTION**

### ***Rejections Repeated***

The 35 U.S.C. 103(a) rejection of claims 19-20,32-33 over Arakawa et al. has been repeated for the reasons made in office action 9/3/2004.

### ***Response to Arguments***

2. Applicant's arguments filed 12/3/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Arakawa et al. teaches away from the use of such a hole in the discussion of the background of the invention, Arakawa et al. teaches that it is notoriously well known in the art at the time applicant's invention was made to provide a first leg of adhesive tape to stick to a third leg of the adhesives tape with an adhesive by forming a penetrated hole at the central portion of the leg (col. 1 lines 37-39) and even though there are problems that the adhesive is exuded through such penetrated hole to make rewinding impossible, applicant does not claim that the backing sheet is rewound. Therefore, Arakawa et al. does not teach away from forming a penetrated hole in the central portion of the leg since the problems that come with the hole deal with rewinding the adhesive tape.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1745

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jane Rhee  
April 13, 2005

GREGG CANTELMO  
PRIMARY EXAMINER

  
Gregg Cantelmo

Form PTO 1448 (Modified)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY DOCKET NO. 192400US55X	SERIAL NO. 09/675,180	
O I P E LIST OF REFERENCES CITED BY APPLICANT JAN 09 2003		APPLICANT David SUDA, et al.			
		FILING DATE September 29, 2000	GROUP 1772		
U.S. PATENT DOCUMENTS					
EXAMINER MANAGER	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS
AA	4,259,958	4/7/81	Goodbar	—	—
AB	5,730,739	3/24/98	Lavash et al.	—	—
AC					
AD					
AE					
AF					
AG	IAN 9 0 2006				
AH					
AI	PTI TRADEMARK OFFICE				
AJ					
AK					
AL					
AM					
AN					
FOREIGN PATENT DOCUMENTS					
	DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION YES NO	
AO					
AP					
AQ					
AR					
AS					
AT					
AU					
AV					
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)					
AW					
AX					
AY					
AZ					
Examiner	<i>Jane L. Hill</i>				
Date Considered 4/13/05					

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<b>Notice of References Cited</b>		Application/Control No.	Applicant(s)/Patent Under Reexamination	
		09/675,180	SUDA ET AL.	
Examiner		Art Unit		Page 1 of 1
Jane Rhee		1745		

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-5,780,150	07-1998	Bloch et al.	428/350
B	US-			
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.